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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,455	03/17/2004	Manfred Heisler	WAS 0627 PUS	4002
22045 7590 08/05/2009 BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075				
EXAMINER				
SORKIN, DAVID L.				
ART UNIT		PAPER NUMBER		
1797				
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08/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/802,455

**Applicant(s)**

HEISLER ET AL.

**Examiner**

DAVID L. SORKIN

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 July 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathur et al. (US 2003/0229175) in view of Schuster et al. (US 5,854,343). Regarding claim 1, Mathur ('175) discloses a continuous process for preparing HTV organopolysiloxane compositions (see [0016]-[0018]) having a viscosity measured at 25 degrees C of at least 500 Pa·s (see [0015]), comprising mixing and kneading organopolysiloxanes and fillers (see [0023]) in a first process stage in a kneading cascade having at least two kneading chamber which are arranged in series (see [0023]), each containing two kneading tools having parallel axes and capable of being driven in co-rotating directions (see [0023]) at least the first kneading chamber having a

feed opening and the last chamber having a discharge opening, to provide a raw organopolysiloxane mixture, and directly feeding the raw organopolysiloxane mixture from the discharge opening into a reciprocating kneader (114) (see [0008], [0009] and [0036] and claim 2 of Mathur '175) wherein the raw material mixture is kneaded and degassed. The first stage kneading is not exactly as claimed in that the material is not expressly disclosed to pass "transverse" to the axis of the kneading tools. Schuster ('343) discloses a kneading cascade having at least two kneading chambers (2) which are arranged in series adjacent one another, each containing two kneading tools (3) having parallel axes and are capable of being driven in co-rotating or counter rotating directions, said chambers being connected to one another by means of openings (5) through which material passes in a direction transverse to the axes (4) of the kneading tools, at least the first kneading chambers having a feed opening (6) and the last chamber having a discharge opening (7), to provide an organopolysiloxane mixture (see drawing and abstract). It would have been obvious to one of ordinary skill in the art to have substituted the kneading cascade of Schuster ('343) for the first stage of Mathur ('175), because Schuster ('343) explains in col. 5, lines 32-37 that the kneading machine provide the benefit of controlling intensity and residence time. Regarding claim 2, the kneading cascade taught by Schuster ('343) comprises from 3 to 10 chambers (see drawing). Regarding claims 3 and 4, the kneading tools taught by Schuster ('343) comprise kneading blades, rollers or polygonal plates (see col. 5, lines 66-67). Regarding claims 5-7, temperature of the reciprocating kneader is regulated (see [0036]). Regarding claim 8, the filler content is from 5 to 80% (see [0026]). Regarding

claim 9, silicas having specific surface area determined by BET method of at least 50 m<sup>2</sup>/g are used as fillers (see [0026]). Regarding claims 10 and 11, polydimethylsiloxanes in accordance with these claims are disclosed or suggested in [0016]-[0018] of Mathur ('175). Regarding claim 12, Schuster ('343) teaches adding organopolysiloxanes having a viscosity measured at 25 degrees C from 10 to 200 mPa's (see col. 6, lines 54-67). Regarding claim 13, both references further teach prehydrophobicized filler. See paragraph [0004] of Mathur '175 "a treating agent is added to reduce silanol functional groups", [0019] of Mathur '175, [0036] of Mathur '175 "pretreated filler", and col. 4, line 17 of Schuster '343 "The fillers (2) are prehydrophobicized". Regarding claim 14, while it should be noted that Mathur ('175) involves some obvious typographic errors (as can be verified by looking at the parent application thereof) such as "2600C" instead of -260°C --, Mathur ('175) [0027]-[0030] and Schuster ('343) col. 6, line 64 each disclose temperature being less than 280°C. Regarding claim 15, Mathur ('175) further discloses adding organopolysiloxane, untreated filler and hydrophobicizing agent to (see [0024]). Regarding claim 16, Mathur ('175) further discloses adding organopolysiloxane, untreated filler and structure improver (see [0024]). Regarding claim 17, as seen in Fig. 1 of Schuster ('343), the absence of an additive inlet in the last chamber, would have suggested that no structure improver is added to the last chamber. Regarding claim 18, Mathur ('175) discloses a continuous process for preparing HTV organopolysiloxane compositions (see [0016]-[0018]) having a viscosity measured at 25 degrees C of at least 500 Pa's (see [0015]), comprising mixing and kneading organopolysiloxanes and fillers (see [0023]) in a first

process stage in a kneading cascade having at least two kneading chamber which are arranged in series (see [0023]), each containing two kneading tools having parallel axes and capable of being driven in co-rotating directions (see [0023]) at least the first kneading chamber having a feed opening and the last chamber having a discharge opening, to provide a raw organopolysiloxane mixture, and directly feeding the raw organopolysiloxane mixture from the discharge opening into a reciprocating kneader (114) (see [0008], [0009] and [0036] and claim 2 of Mathur '175) wherein the raw material mixture is kneaded and degassed, wherein the raw mixer is a viscous, homogeneous, cohesive composition prior to entering the reciprocating kneader (see [0023]). The first stage kneading is not exactly as claimed in that the material is not expressly disclosed to pass "transverse" to the axis of the kneading tools. Schuster ('343) discloses a kneading cascade having at least two kneading chambers (2) which are arranged in series adjacent one another, each containing two kneading tools (3) having parallel axes and are capable of being driven in co-rotating or counter rotating directions, said chambers being connected to one another by means of openings (5) through which material passes in a direction transverse to the axes (4) of the kneading tools, at least the first kneading chambers having a feed opening (6) and the last chamber having a discharge opening (7), to provide an organopolysiloxane mixture (see drawing and abstract). It would have been obvious to one of ordinary skill in the art to have substituted the kneading cascade of Schuster ('343) for the first stage of Mathur ('175), because Schuster ('343) explains in col. 5, lines 32-37 that the kneading machine provide the benefit of controlling intensity and residence time. Regarding

claims 19 and 20, Mathur ('175) discloses a continuous process for preparing HTV organopolysiloxane compositions (see [0016]-[0018]) having a viscosity measured at 25 degrees C of at least 500 Pa·s (see [0015]), comprising mixing and kneading organopolysiloxanes, fillers untreated fillers and at least one of a hydrophobicizing agent or structure improver (see [0020] to [0023]) in a first process stage in a kneading cascade having at least two kneading chamber which are arranged in series (see [0023]), each containing two kneading tools having parallel axes and capable of being driven in co-rotating directions (see [0023]) at least the first kneading chamber having a feed opening and the last chamber having a discharge opening, to provide a raw organopolysiloxane mixture, and directly feeding the raw organopolysiloxane mixture from the discharge opening into a reciprocating kneader (114) (see [0008], [0009] and [0036] and claim 2 of Mathur '175) wherein the raw material mixture is kneaded and degassed. The first stage kneading is not exactly as claimed in that the material is not expressly disclosed to pass "transverse" to the axis of the kneading tools. Schuster ('343) discloses a kneading cascade having at least two kneading chambers (2) which are arranged in series adjacent one another, each containing two kneading tools (3) having parallel axes and are capable of being driven in co-rotating or counter rotating directions, said chambers being connected to one another by means of openings (5) through which material passes in a direction transverse to the axes (4) of the kneading tools, at least the first kneading chambers having a feed opening (6) and the last chamber having a discharge opening (7), to provide an organopolysiloxane mixture (see drawing and abstract). It would have been obvious to one of ordinary skill in the art to

have substituted the kneading cascade of Schuster ('343) for the first stage of Mathur ('175), because Schuster ('343) explains in col. 5, lines 32-37 that the kneading machine provide the benefit of controlling intensity and residence time.

***Response to Arguments and Declarations***

4. The rule 131 declaration is unsatisfactory, because the translation and statement of accuracy required by rule 69(b) is not provided. The declaration states that an English translation of the examples may be found on pages 12-15 of the specification; however, it is clear that pages 12-15 of the specification, though related, are not an actual translation of the document. Firstly, of the three examples on pages 12-14 of the specification, only one seems to be discussed in the German document, but there are other differences as well.

5. The rule 132 declaration is unsatisfactory because it does not refer to the reference being relied upon, US 2003/0229175, but instead refers to a different reference by the same inventor.

***Conclusion***

6. This is a RCE of applicant's earlier Application No. 10/802,455. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID L. SORKIN whose telephone number is (571)272-1148. The examiner can normally be reached on Mon.-Fri. 7:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter D. Griffin can be reached on 571-272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID L. SORKIN/  
Primary Examiner, Art Unit 1797